

Oral Hearing Held:
April 27, 2005

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB**

Mailing Date:
August 16, 2005
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Northern Safety Co., Inc.*

Serial No. 76462786

G. Franklin Rothwell, Carla C. Calcagno, and Anne M. Sterba of Rothwell, Figg, Ernst & Manbeck P.C. for *Northern Safety Co., Inc.*

Julie A. Watson, Trademark Examining Attorney, Law Office 113 (Odette Bonnet, Managing Attorney).

Before *Hohein, Holtzman and Rogers*, Administrative Trademark Judges.

Opinion by *Hohein*, Administrative Trademark Judge:

Northern Safety Co., Inc. has filed an application to register on the Principal Register the mark "NORTHERN SAFETY CO. INC." and design, as reproduced below,



for "retail and wholesale store services in the field of industrial and safety equipment, products and supplies via a catalog, mail orders and the Internet."¹

¹ Ser. No. 76462786, filed on October 25, 2002, which is based on an allegation of a date of first use anywhere and in commerce of November

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its services, so resembles the following marks, which are registered by the same registrant on the Principal Register for the services set forth below, as to be likely to cause confusion, or to cause mistake, or to deceive:²

(i) the mark "NORTHERN TRACTOR & POWER" and design, as illustrated below,



which is registered for "retail store services and mail order catalog services in the fields of tractors, forklifts, machinery, hydraulic equipment and parts and accessories therefor, gas generators and parts and accessories therefor, diesel generators and parts and accessories therefor, log splitters, agricultural and landscape equipment and parts and accessories therefor, material handling products, lawn and garden products, water pumps, pressure washers and parts and accessories therefor, tires and trailers";³

1998. The words "SAFETY CO. INC." are disclaimed. The stippling is for shading purposes only and does not represent color.

² Registration also has been finally refused on the basis of Reg. No. 1,368,651, which issued to a different registrant on November 5, 1985 for the mark "NORTHERN BLOWER" and design for "industrial air handling equipment; namely, blowers and parts therefor." However, while such registration has been renewed and thus is subsisting, the Examining Attorney states in her brief that, "[a]fter further consideration of the applicant's arguments, the refusal to register applicant's mark under Section 2(d) of the Trademark Act on the grounds that it so resembles Registration No. 1368651 is WITHDRAWN." In view thereof, no further consideration will be given to such registration as a possible bar to the mark which applicant seeks to register.

³ Reg. No. 2,541,529, issued on February 19, 2002, which sets forth a date of first use anywhere and in commerce of March 2000. The terms "TRACTOR & POWER" are disclaimed. The mark is described as consisting of the terms "'NORTHERN TRACTOR & POWER' and a stylized design of a tire and lightning bolt."

(ii) the mark "NORTHERN," in standard character form, which is registered for "retail store services and mail order catalog services in the fields of hand tools, electric power tools, air-powered tools, abrasives, machinery, hydraulic equipment and parts and accessories therefor, gas engines and gas generators and parts and accessories therefor, diesel engines and diesel generators and parts and accessories therefor, electric motors, inverters, wind turbines, log splitters, log splitting wedges and parts and accessories therefor, agricultural and landscape equipment and parts and accessories therefor, solar lights and panels, material handling products, kerosene, propane and electric heaters, chainsaws, pet and pest control products, lawn and garden products, work clothing, gloves, tarpaulins and accessories therefor, straps and tie downs, air compressors and accessories therefor, parts washers, sandblasting tools and accessories therefor, welders and welding parts and accessories, metal fabrication products, parts and accessories, lighting products, painting products, propane products, outdoor, camping and recreational products and clothing, two-way radios, go karts and parts and accessories therefor, parts and accessories for all terrain vehicle[s], recreational vehicles and parts and accessories therefor, automotive products, parts and accessories, bearing drives and accessories, water pumps, pressure washers and parts and accessories therefor, tires, cleaning and maintenance equipment and supplies, testing equipment, trailers and parts and accessories therefor, toys and accessories, security equipment and accessories, [and] meat processing equipment and accessories";⁴

(iii) the mark "N NORTHERN TOOL & EQUIPMENT CO." and design, as depicted below,



⁴ Reg. No. 2,441,069, issued on April 3, 2001, which sets forth a date of first use anywhere and in commerce of January 1981.

which is registered for "retail store services and mail order catalog services in the fields of hand tools; electric power tools; air-powered tools; machinery; hydraulic equipment and parts and accessories; gas engines and gas generators and parts and accessories therefor; diesel generators, parts and accessories therefor; electric motors; inverters; wind turbines; log splitters; log wedges and parts and accessories therefor; agricultural and landscape equipment and parts and accessories therefor; solar lights and panels; material handling products; kerosene, propane and electric heaters; chainsaws; pet and pest control products; lawn and garden products; work clothing; gloves; tarpaulins; air compressors and accessories; parts washers; sandblasting tools and accessories; welders and welding parts and accessories; metal fabrication products, and parts and accessories; lighting products; painting products; propane products; outdoor, camping, hunting and recreational products and clothing products therefor; two-way radios; go-karts and parts and accessories therefor; all terrain vehicle and recreational vehicle products, parts and accessories; automotive products, parts and accessories; water pumps; pressure washers, and parts and accessories; tires[;] maintenance and testing equipment; and, trailers, and parts and accessories";⁵ and

(iv) the mark "NORTHERN TOOL & EQUIPMENT CO." and design, as shown below,

NORTHERN
Tool & Equipment Co.

which is likewise registered for the same retail store services and mail order catalog services as set forth above with respect to the registration for the mark "N NORTHERN TOOL & EQUIPMENT CO." and design.⁶

⁵ Reg. No. 2,289,006, issued on October 26, 1999, which sets forth a date of first use anywhere and in commerce of August 1, 1998. The terms "TOOL & EQUIPMENT CO." are disclaimed.

⁶ Reg. No. 2,289,007, issued on October 26, 1999, which sets forth a date of first use anywhere and in commerce of August 1, 1998. The terms "TOOL & EQUIPMENT CO." are disclaimed.

Applicant has appealed. Briefs have been filed and an oral hearing was held. We reverse the refusal to register with respect to the three cited "NORTHERN" and design marks but affirm such refusal as to the cited "NORTHERN" mark in standard character form.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations which are usually involved are the similarity or dissimilarity in the goods and/or services at issue and the similarity or dissimilarity of the respective marks in their entireties.⁷ Nonetheless, inasmuch as applicant, as pointed out by the Examining Attorney in her brief, "does not dispute the similarities of the services"⁸ and, "[i]n fact, the services [at issue] are identical at least in part,"⁹ the primary

⁷ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and/or services] and differences in the marks." 192 USPQ at 29.

⁸ Applicant, as discussed later herein, emphasizes instead the *du Pont* factor concerning the conditions under which and buyers to whom sales are made, asserting that customers for the respective services are careful, sophisticated purchasers rather than impulsive buyers.

⁹ Specifically, the Examining Attorney notes in her brief that (emphasis in original):

As the excerpts from the applicant's website and attached to the final Office action ... indicate, the **industrial and safety equipment** sold by applicant includes

focus of our inquiry is accordingly on the similarity or dissimilarity of the respective marks in their entireties.

Applicant argues in its initial brief that, in view of the evidence which it has made of record, confusion is not likely. Specifically, applicant maintains that not only do it and the cited registrant "use NORTHERN in their marks to suggest their businesses' regional origin," but the record shows that "[b]ecause of this, *twenty-seven* different parties have used or registered *thirty* (30) trade names and marks for the *same goods*" sold by the cited registrant through its retail store services and mail order catalog services (*italics in original*). Citing also, for the first time in its initial brief, a definition from Webster's II New Collegiate Dictionary (1999) which at 747 defines "northern" as "1. Located toward, in, or facing the north. 2. Coming from the north, as a wind. 3. Growing in the North,"¹⁰ applicant contends that because such term "projects an ordinary meaning in the English language," purchasers of applicant's and the cited registrant's services will assume that the term "NORTHERN" is being used in the respective marks to suggest regional origin. Consequently, and as shown by the

the following goods (**all sold by the registrant**): electric power tools, hydraulic tools, material handling equipment, industrial work clothing and gloves, power washers generators, drive motors, lighting equipment and painting equipment.

¹⁰ While such definition is technically untimely under Trademark Rule 2.142(d), we have nonetheless considered it inasmuch as it is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir.

appreciable number of third-party registrations and/or uses of marks which consist of or include such term, applicant insists that when encountering the marks at issue herein, "purchasers will rely on elements other than NORTHERN to distinguish source."

In particular, applicant relies in its initial brief on the following propositions, citing as support therefor the sections of the TMEP noted below (*italics in original*):

Precedent teaches that a party *may* rely on evidence of third[-]party registrations to show that a shared portion of two marks is inherently weak or diluted. Specifically, TMEP Section 1207.01(d)(iii) teaches that:

Third-party registrations may be relevant to show that the mark or a portion of the mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services.

Precedent also teaches that where, as here, a term is weak or highly suggestive, consumers can *easily* distinguish between marks containing a common term by even descriptive additions to the term. *Id.* Specifically, TMEP §1207.01(b)(iii) states that:

Exceptions to the above stated general rule [that adding a term to a common portion of two marks does not prevent confusion] [...] may arise if: ... (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted. [...]

Here, applicant asserts, it has shown that the term "NORTHERN" is diluted, and hence weak, by making of record Internet

1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n. 7 (TTAB 1981).

advertisements from "*twenty-one different entities*" in allegedly the same fields as those of the cited registrant, e.g., NORTHERN SUPPLY for safety and tooling supplies; NORTHERN LIGHTS for electrical generator power sets; and NORTHERN LIGHTS VEHICLES for safety supplies" (*italics in original*). Applicant stresses that "[m]ost, if not all, of these numerous listed entities which are using 'NORTHERN' in their trade names originate in Canada, the Northern United States or the northern part of a State" and thus such entities "use the term in their marks and names in its regional sense, i.e., to refer to the fact that the respective businesses and organizations are located in the Northern United States or Canada."

Based thereon, applicant further urges in its initial brief that:

This evidence shows that the public has been exposed to references to NORTHERN in both trade names and marks. From this, the Board can infer that the public would not regard NORTHERN as such an unusual term in a trade name or mark that they would expect all companies with NORTHERN in their names to be related, or all products or services with NORTHERN in their marks to emanate from a single source.

Applicant also cites therein the following language from *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565-66 (TTAB 1996), in arguing in favor of the registrability of its mark: "Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to other elements of the marks as a means of distinguishing the source of goods or services in the field."

In light of all of the above, applicant asserts that its mark and the cited registrant's marks, when considered in their entirety, "neither look alike nor sound alike," "[n]or do they project the same meaning." Noting, moreover, that such marks overall "project differing commercial impressions," applicant specifically points out that its mark "is a stylized version of the word 'Northern' together with the words 'Safety Co. Inc.' in a distinctive design," while the cited registrant's composite marks include either the terms "'Northern Tractor & Power' ... accompanied by a tractor wheel in motion representing power and even friction" or simply feature the terms "Tool & Equipment" with or without a stylized depiction of the letter "N." As such, applicant insists that in its mark the terminology "'Northern Safety' implies a company selling devices that protect" or "a company selling safety devices," while in the cited registrant's composite marks it is respectively the case that the phrase "'Northern Tractor' implies a company selling tractors and tractor supplies" and likewise the language "Tool & Equipment" denotes a company marketing those kinds of products.

Lastly, applicant contends in its initial brief that, "[m]ost importantly, purchasers will not confuse NORTHERN SAFETY CO. INC and Design and the [cited] registered marks because Applicant sells only to discriminating purchasers." Applicant argues that as proof that it "sells to sophisticated consumers, one need only refer to the Applicant's recitation of services," asserting that purchasers of "industrial and safety equipment" would "exercise great care in selecting such equipment as lives

and health will depend on it." In particular, applicant contends that (*italics in original*):

The reason that sophisticated consumers will not be confused is that no reason to correlate the ... [respective] marks exists. Except for the term NORTHERN, the marks neither look alike, nor sound alike, nor have the same meaning. The Examiner has failed to present any theory why sophisticated purchasers will confuse the marks.

The Examining Attorney, on the other hand, asserts in her brief that confusion is likely because the marks at issue "all share the identical dominant word NORTHERN." Applicant, the Examining Attorney notes, does not argue to the contrary but, instead, "argues that the term NORTHERN is weak and diluted" and that the respective marks "create different overall commercial impressions." However, as to the third-party registrations relied upon by applicant as evidence of the weakness of the term "NORTHERN," the Examining Attorney maintains that (*underlining in original*):

Prior decisions and actions of other ... examining attorneys in registering different marks are without evidentiary value and are not binding upon the Office. Each case is decided on its own facts, and each mark stands on its own merits. *AMF Inc. v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (C.C.P.A. 1973); ... *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984)

Moreover, a review of these third party registrations indicates that all but one of them are for specific goods and not for retail or wholesale store services. The one third[-]party registration that is for retail services ... was cancelled on July 3, 2004. Still further, several of these marks when considered as a whole present a completely different commercial impression. For example, Registration No. 1232499 for the

mark NORTHERN LIGHTS is a third[-]party registration containing the word NORTHERN but when viewed as a whole creates its own separate overall meaning and commercial impression.

.... In the present case, all of the third[-]party registrations containing the word NORTHERN (but for one cancelled registration) are for various goods but NO specific retail services for industrial and safety equipment, products and supplies similar to either the applicant['s] or [the cited] registrant[']s. In fact, the only marks containing the word NORTHERN for highly similar [and identical in part] retail and/or wholesale services are the applicant['s] and the cited registrant[']s.

In addition, as to the Internet advertisements relied upon by applicant to further demonstrate the asserted weakness of the term "NORTHERN," the Examining Attorney urges that:

By doing this, applicant seeks to introduce collateral evidence that is of little probative value. This is inappropriate in an *ex parte* proceeding. TMEP §1207.01(d)(iv). Section 7(b) of the Trademark Act, 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register shall be *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark and of the registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate. During *ex parte* prosecution, an applicant will not be heard on matters that constitute a collateral attack on the cited registration. See *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re Calgon Corp.* 435 F.2d 596, 168 USPQ 278 (C.C.P.A. 1971)

However, as applicant correctly points out in its reply brief, it is simply not the case that "considering evidence of third-party use in a *ex parte* proceeding impermissibly collaterally attacks the cited registrations." Applicant plainly is not arguing that the cited registrations are invalid because the marks which are

the subjects thereof are, for instance, either primarily geographically descriptive or deceptively misdescriptive; rather, applicant contends that such marks are weak, and hence entitled to a narrow scope of protection, because the term "NORTHERN" therein is highly geographically suggestive, as shown by the dictionary meaning thereof, the numerous third-party registrations of marks which consist of or contain such term, and the not insubstantial number of third-party usages of such marks. Accordingly, it is proper to consider the Internet advertising made of record by applicant along with the dictionary and third-party registration evidence.

In any event, the Examining Attorney additionally argues that, "[e]ven if applicant has shown that the [term NORTHERN in the] cited mark[s] is 'weak,' such marks are still entitled to protection against registration by a subsequent user of the same or similar mark for the same or closely related goods or services." Here, the Examining Attorney insists, "[t]he term NORTHERN is not weak with regard to the relevant services" inasmuch as the cited "registrant's marks are the only marks on the register that contain the term NORTHERN in relationship to the applicant's and registrant's recited services." Furthermore, the Examining Attorney contends that:

The overall commercial impression of the marks is the same. Registration No. 2441069 is [for] the typed drawing [of the mark] NORTHERN. Registration of a mark in typed or standard character form means that the mark may be displayed in any lettering style. 37 C.F.R. §2.52(a). The rights associated with a mark in typed or standard character form reside in the wording itself, and the registrant is free to adopt any style of

lettering, including lettering identical to that used by applicant. Therefore, applicant's presentation of its mark in special form will not avoid likelihood of confusion with a mark that is registered in typed or standard character form because the marks presumably could be used in the same manner of display. See ... *In re Pollio Dairy Prods. Corp.*, 8 USPQ2d 2012 (TTAB 1988); ... [s]ee also TMEP §1207.01(c)(iii).

With regard to Registration Nos. 2541529, 2289007 and 2289006, a review of the marks [which are the subjects thereof] ... demonstrates that the marks DO create the same overall commercial impression. The applicant's mark and the registrant's marks all have the dominant word NORTHERN appearing in larger font and on top of highly descriptive and/or generic wording that appears directly below and in smaller font.

In view of the above, and citing, *inter alia*, *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), for the proposition, as stated therein, that "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines," the Examining Attorney concludes that confusion is likely from contemporaneous use of the marks at issue herein in connection with services which are not only highly similar but in fact are identical at least in part. The Examining Attorney, moreover, adheres to her conclusion, notwithstanding applicant's argument that the customers for its services and those of the cited registrant are generally careful and discriminating buyers. Specifically, citing *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983); and TMEP §1207.01(d)(vii), she maintains that "[t]he fact

that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks [or service marks] or immune from source confusion." Finally, citing *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988), the Examining Attorney adds that "[a]ny doubt regarding a likelihood of confusion must be resolved in favor of the prior registrant."

Upon consideration of the evidence and arguments presented, we concur with applicant that contemporaneous use of its "NORTHERN SAFETY CO. INC." and design mark in connection with "retail and wholesale store services in the field of industrial and safety equipment, products and supplies via a catalog, mail orders and the Internet" is not likely to cause confusion with any of the cited registrant's "NORTHERN" and design marks for various "retail store services and mail order catalog services." Specifically, we agree that in view of both (i) the demonstrated weakness of the term "NORTHERN," as shown by its geographical suggestiveness as well as the use thereof in an appreciable number of marks by third parties, and (ii) the differences in the design elements and associated descriptive wording, in each instance, between applicant's mark and the cited registrant's "NORTHERN TRACTOR & POWER" and design mark, its "N NORTHERN TOOL & EQUIPMENT CO." and design mark and its "NORTHERN TOOL & EQUIPMENT CO." and design mark, such marks are distinguishable. Thus, and given that the respective services, although identical in part and otherwise commercially related as applicant has

conceded, would indeed be sold principally to sophisticated and discriminating purchasers, the overall differences in appearance, sound, connotation and commercial impression in applicant's mark and the cited registrant's "NORTHERN" and design marks are sufficient to preclude a likelihood of confusion.

We are constrained to find, however, that confusion is likely from the use by applicant of its mark for its services contemporaneously with the use by the cited registrant of its mark "NORTHERN" in standard character form for its identical in part and otherwise commercially related "retail store services and mail order catalog services." In particular, we note in this regard that the cited registrant's "NORTHERN" mark must be considered substantially similar in appearance to applicant's "NORTHERN SAFETY CO. INC." and design mark, given that such marks must be considered identical in their manner of display of the term "NORTHERN." The reason therefor is that the cited registrant's "NORTHERN" mark, being registered in standard character or typed format, covers the display of the term "NORTHERN" in any reasonable stylization of lettering--including a slanted display of all capital block letters of the same size except for a significantly larger first letter "N"--utilized by applicant in its mark for the same term. See, e.g., *Phillips Petroleum Co. v. C. J. Webb, Inc.* 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) [a mark registered in typed or standard character form is not limited to the depiction thereof in any special form]; and *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992) ["[a]s the *Phillips Petroleum* case makes clear,

when [an] applicant seeks a typed or block letter registration of its word mark, then the Board must consider all reasonable manners in which ... [the word mark] could be depicted"]. It consequently is not a valid argument to contend that there is a distinguishable difference in appearance between applicant's mark and the cited registrant's "NORTHERN" mark. See, e.g., Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (*italics in original*):

[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a *difference* cannot legally be asserted by that party. Thus, ... the displays must be considered the same.

Moreover, applicant's mark and the cited registrant's "NORTHERN" mark are substantially similar in sound, connotation and commercial impression. While it is indeed the case that such marks must be considered in their entirety, including the descriptive words "SAFETY CO. INC." in applicant's mark, our principal reviewing court has indicated that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entirety." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is descriptive ... with respect to the

involved ... services is one commonly accepted rationale for giving less weight to a portion of a mark" Id.

Here, in light of the descriptive words "SAFETY CO. INC." in applicant's mark, we agree with the Examining Attorney that, when such mark is considered as a whole, the dominant and distinguishing portion thereof is the word "NORTHERN," which is identical to the entirety of the cited registrant's "NORTHERN" mark. Furthermore, because the latter mark contains no additional element by which even sophisticated purchasers could differentiate such mark from applicant's mark, the marks overall are substantially similar in sound, appearance and connotation and project essentially the same commercial impression. Thus, even though the term "NORTHERN," as demonstrated by applicant, is considered a weak term due to its geographical suggestiveness, it is still the case that, when used in connection with services which are identical in part and otherwise commercially related, confusion as to the source or sponsorship of such services is likely to occur.

Moreover, as noted previously, while purchasers of the respective services would undoubtedly be sophisticated in that they would be knowledgeable as to their equipment needs and safety requirements, it nevertheless is well settled that the fact that buyers may exercise care and deliberation in their choice of services and the goods offered thereby "does not necessarily preclude their mistaking one ... [service mark] for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v.*

Rinco, Inc., 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also In re Decombe, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983). Such would especially be the case where, as here, applicant's "NORTHERN SAFETY CO. INC." and design mark and registrant's "NORTHERN" mark are so substantially similar that they basically differ only as to the presence of the descriptive words "SAFETY CO. INC." in applicant's mark. Confusion is thus likely from the use thereof in connection with services which are identical in part and otherwise commercially related. As indicated in In re Research & Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986):

Appellant's argument that purchasers of safety devices would not be confused because of the care they would be expected to exercise in the selection of that equipment is not persuasive in view of the very close similarity between the marks. That the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods. "Human memories even of discriminating purchasers ... are not infallible." *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 1406, 168 USPQ 110, 112 (CCPA 1970). Sophistication of buyers and purchaser care are relevant considerations but are not controlling on this factual record.

Decision: The refusal under Section 2(d) is reversed with respect to the three cited "NORTHERN" and design marks but such refusal is affirmed as to the cited "NORTHERN" mark in standard character form.